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Examiner: **Pesin, Boris M.**

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Docket No. RSW920010012US1

Serial No. 09/845,537

Atty: GRW / JVL

Applicant: Molander

☒ Transmittal Letter (2 copies)

☐ Amendment (☐ pages)

☐ Amendment AF

☐ Ext. of Time

☐ IDS Statement

☐ Other

☒ Certificate of Facsimile (incl. w/Replyl Brief)

☐ Notice of Appeal

☐ Appeal Brief

☒ Reply Brief (5 pages)

☐ Change of Address

Deposit Acct. No. 09-0461

Fees: Amendment ☐ Notice of Appeal ☐ Appeal Brief ☐ Other ☐

File: **IBM-R105**

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

IBM DOCKET NO. RSW920010012US1

DATE: August 2, 2005

Application Serial No.: 09/845,537

Sir:

Assignee Name: International Business Machines Corporation
Assignee Residence: Armonk, New York

Transmitted herewith for filing is the Patent Application of:

Inventors: Molander

For: **System and Method for Multifunction Menu Objects**

Enclosed are:

X Reply Brief

Any additional filing fees have been calculated as shown below:

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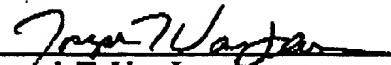
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X Any patent application processing fees under 37 CFR Sect. 1.17.

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Respectfully submitted,

By



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Atty Ref. No. IBM-R105

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

IBM DOCKET NO. RSW920010012US1
DATE: August 2, 2005

Application Serial No.: 09/845,537

Sir:

Assignee Name: International Business Machines Corporation
Assignee Residence: Armonk, New York

Transmitted herewith for filing is the Patent Application of:

Inventors: Molander

For: System and Method for Multifunction Menu Objects

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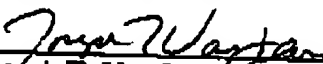
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Atty Ref. No. IBM-R105

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
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Molander

Serial No.: 09/845,537

Filed: April 30, 2001

Title: System and Method for
Multifunction Menu Objects

§ Group Art Unit: 2174

§

§ Examiner: Pesin, Boris

§

§ Attorney Docket No. RSW920010012US1

§

§

§ IBM Corporation

§ Software Group IP Law -- T81/503

§ 3039 Cornwallis Road

§ Research Triangle Park, NC 27709

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Joseph T. Van Leeuwen8/2/05
Date**APPELLANT'S REPLY BRIEF**Mail Stop Appeal Brief-Patents
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Sir:

A. INTRODUCTORY COMMENTS

This reply brief is in response to the Examiner's Answer mailed June 3, 2005. No fees are believed to be necessary at this time. In the event any fee is owed, however, please charge such fee or credit any overpayment to IBM Corporation Deposit Account No. 09-0461.

No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Docket No. RSW920010012US1

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Atty Ref. No. IBM-R105

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B. REPLY TO EXAMINER'S ANSWER

Related Appeals and Interferences

Appellant disagrees that there is no statement in Appellant's Appeal Brief regarding Related Appeals and Interferences. Appellant notes that Appendix K of Appellant's Brief, entitled "RELATED PROCEEDINGS" clearly states that such proceedings were "not applicable" to Appellant's Brief.

The Google Reference and Appellant's Rule 1.131 Declaration

Appellant asserts that, even if the Google Reference was prior art, it does not anticipate Appellant's claimed invention. The reasons for Appellant's assertion are set forth in Appellant's Appeal Brief. Appellant notes that, for the first time, Examiner alleges in the Examiner's Answer that the phrase "menu item graphical control" is not specifically defined in Appellant's specification. Appellant points out that this phrase has been in Appellant's specification since the application was first filed and that the phrase means simply what it says – namely a graphical control in a menu item. Support for a graphical control in a menu item is found throughout Appellant's specification (see Figures 1-4 and descriptions found throughout the specification). Appellant also respectfully points out that the Examiner did not raise any objections or rejections (i.e., under 35 U.S.C. § 112) regarding terms found in Appellant's claims in any previous Office Actions (see MPEP § 707.07 regarding Completeness and Clarity of Examiner's Action).

Appellant respectfully disagrees that Appellant's declaration filed under 37 CFR 1.131 is invalid and bears no weight. Again, the reasons for Appellant's assertion are set forth in Appellant's Appeal Brief. Instead, Appellant respectfully asserts that (1) the rejection of Appellant's claims is invalid as non-patent art cannot be used to support a rejection under 35 U.S.C. § 102(e), and (2) the Google reference cannot be used as a prior art reference because it has no publication date. Details regarding these assertions are set forth in the following sections.

(1) Invalid Rejection Under 35 U.S.C. § 102(e)

The Examiner has rejected Appellants' claims under 35 U.S.C. § 102(e). This is an invalid rejection. 35 U.S.C. § 102(e) provides for two types of rejections. 35 U.S.C. § 102(e)(1) provides for rejections based upon an "application for patent, published under section 122(b)," and 35 U.S.C. § 102(e)(2) provides for rejections based upon a granted patent. Because the Google reference is not a patent application publication, nor is it a granted patent, it cannot be

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used as a reference in a § 102(e) rejection. Instead, the rejection must be made under 35 U.S.C § 102(a).

(2) The Google Reference is Not a Valid Prior Art Reference

Appellant observes that there is absolutely no publication date on the Google reference whatsoever. MPEP § 2128 deals with "Printed Publications" as prior art. This section states that while Electronic Publications can be used as prior art, if the publication does not include a publication date (or retrieval date) it cannot be relied on as prior art under 35 U.S.C § 102(a) or (b). In the preceding section, Appellant pointed out that the Examiner improperly rejected Appellants' claims under 35 U.S.C. § 102(e) and that the rejection should have been made under 35 U.S.C § 102(a). Therefore, Appellant respectfully asserts that, because a publication date does not appear on the Google Toolbar reference, the earliest date that can be relied upon by the Examiner is October 24, 2004 (the retrieval date of the reference). Accordingly, the Google Toolbar reference is not a valid prior art reference to Appellant's application.

Appellant has provided a copy of a portion of MPEP § 2128, with emphasis added, for the Examiner's consideration and review:

2128 "Printed Publications" as Prior Art

...

ELECTRONIC PUBLICATIONS AS PRIOR ART

Status as a "Printed Publication"

An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981) ("Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a 'printed publication' * * * should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." (citations omitted).). See also *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228, 53 USPQ2d 1115, 1119 (W.D. Wash. 1999) (Pages from a website were relied on by defendants as an anticipatory reference (to no avail), however status of the reference as prior art was not challenged.); *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (Database printouts of abstracts which were not themselves prior art publications were properly relied as providing evidence that

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the software products referenced therein were "first installed" or "released" more than one year prior to applicant's filing date.).

The Office policy requiring recordation of the field of search and search results (see MPEP § 719.05) weighs in favor of finding that Internet and on-line database references cited by the examiner are "accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." Wyer, 655 F.2d at 221, 210 USPQ at 790. Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.

Date of Availability

Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. *If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b).* although it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication. See MPEP § 901.06(a), paragraph IV. G.

...

MPEP § 2128 provides that a "publication date" *must appear on the Google reference*, otherwise the earliest date that can be inferred is the date of retrieval. On form PTO-892, the Examiner alleges that the date of the Google reference is "02/02/2001." However, this date does not appear *anywhere* on the Google reference. MPEP § 2128 provides no means whatsoever for the Examiner to assert a publication date that does not appear on the reference itself. MPEP § 2128 is quite clear and unequivocal that a reference that does not include a publication date *cannot be relied upon* as prior art under 35 U.S.C. § 102(a).


Thus, for at least the reasons stated above, claims 1-5, 7-17, and 19-26 are patentable over the cited references. Appellants respectfully submit that claims 1-5, 7-17, and 19-26 were improperly rejected under 35 U.S.C. § 102 and respectfully request that the rejection be *reversed*.

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Conclusion

In view of the foregoing, Appellants respectfully request that the Examiner's claim rejections be reversed and the present application be allowed.

Respectfully submitted,

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